Remarks

Claims 1 to 3 are pending.

In the Final Office Action, the Examiner again rejected claims 1 to 3 under 35 U.S.C. § 103(a) as allegedly unpatentable over DeGasparo *et al.* (WO 97/31634) and Hauel *et al.* (U.S. Patent No. 5,594,003).

In response, applicants respectfully traverse the Examiner's rejection and maintain that a *prima facie* case of obviousness has not been established. A *prima facie* case of obviousness requires the satisfaction of three criteria: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references; (ii) there must be a reasonable expectation of success; and (iii) the references when combined must teach or suggest all of the claim limitations. *See* M.P.E.P. § 2143.

Applicants maintain that there is not a specific suggestion or motivation either in DeGasparo *et al.* or Hauel *et al.* themselves or in the knowledge generally available to one of ordinary skill in the art, to modify DeGasparo *et al.* or Hauel *et al.*, and further maintain that neither DeGasparo *et al.* or Hauel *et al.* provide the required reasonable expectation of success to establish a *prima facie* case of obviousness.

DeGasparo *et al.* and Hauel *et al.* both relate to telmisartan. DeGasparo *et al.* assumes that a number of the disclosed compounds will be able to form acid addition salts (see columns 51 and 56), but does not teach which of the compounds so described actually form acid addition salts. Thus, while DeGasparo *et al.* discloses telmisartan (see columns 52 and column 60, example 9 (compound D)), no acid addition salt is disclosed for telmisartan by DeGasparo *et al.* nor are such salts shown to be useful. Similarly, Hauel *et al.* simply assumes that for each of the AT_1 receptor antagonists disclosed there exists a pharmaceutically utilizable salt. DeGasparo *et al.* teaches that a number of the disclosed AT_1 receptor antagonists which possess a basic center form acid addition salts but does not specifically indicate which of the disclosed AT_1 receptor antagonists actually fulfill these criteria. As telmisartan is an AT_1 receptor antagonist which carries an acidic carboxy group, thus neither DeGasparo *et al.* nor Hauel *et al.*, alone or in combination, provide any indication or suggestion whether telmisartan is able to form acid addition salts as disclosed and taught in the instant

application. Accordingly, applicant respectfully request that the Examiner reconsider and withdraw the rejection. Applicants also point out that the Examiner has not explained the basis for rejecting claim 3 over DeGasparo *et al.* or Hauel *et al.*

Applicants submit that all the pending claims are allowable and respectfully solicit a Notice of Allowance for all of the pending claims. If the Examiner feels that a telephone interview would be helpful in advancing prosecution of this application, the Examiner is invited to contact the attorney below.

Certificate of Mailing Under 37 C.F.R. § 1.8(a)
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on February 1, 2006.

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